

Serial No. 09/922,066
Filed: August 3, 2001

REMARKS

Claims 1-70 were pending in the subject application.

Claims 10-12, 16-34, 36-38, 46-49 and 53-66 stand withdrawn by the Examiner.

Claims 1, 67 and 69 are amended.

Claim 70 is canceled without prejudice or disclaimer of subject matter.

Accordingly, claims 1-69 are pending in the subject application.

The claims are amended to more clearly define the subject matter of the present invention. More specifically, claims 1 and 67 are amended to correct obvious typographical errors. Claim 69 is amended to adopt the language suggested by the Examiner. Applicants propose that the above amendments do not narrow the scope of any pending claim or claim element. No new matter added.

Applicants request reconsideration of the pending claims in light of the above claim amendments taken along with the following remarks.

Election / Restriction

The Examiner has required an election of species in the present application. Applicants traverse the Examiner's search limitations described on page 4 of the current office action. For example, the Examiner has limited R to hydrogen. In claim 1, R may be hydrogen or halogen. Applicants submit that the Examiner has not shown any serious burden to include R as both hydrogen and halogen as opposed to only hydrogen.

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The Examiner has limited R2 to alkyl or hydrogen. Applicants submit that there has not been shown any serious burden on the Examiner to include R2 as alkyl, hydrogen, alkoxy, halogen or CF₃, as originally claimed. Applicant further submits that the Examiner has not shown a serious burden in the examination of R3, R3', R4 and R4' as originally claimed.

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If the members of a Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. MPEP § 803.02

As discussed below, it is Applicants' position that rejections of the current office action are overcome. Therefore, under the election of species guidelines, the Examiner is requested to extend the examination as necessary. "Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection ... the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim." MPEP § 803.02

Claim Objections

Claim 67 stands objected to as being dependent upon itself. Applicants have amended claim 67 to correct this obvious typographical error. Reconsideration and withdrawal of the objection to claim 67 is requested.

Claim Rejection – 35 USC 112

Claims 1-9, 13-15, 35, 39, 40-43, 44, 45, 50, 51, 52 and 68-70 stand rejected under 35 USC 112, second paragraph, as failing to set forth the subject matter which Applicants regard as their invention.

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It appears that the Examiner rejects claim 67 as failing to correspond in scope of claim 1. Applicants respectfully submit that claim 67, now dependent upon claim 66, corresponds in scope with that which Applicants regard as the invention. Should the Examiner disagree, Applicants request a more detailed statement of rejection in order to formulate an adequate reply.

The Examiner rejects claim 1 under 35 USC 112, second paragraph because the language "aryl, ... substituted" is not acceptable. The Examiner states that this term does not exactly and definitely tell the exact positions of the substituents. Aryl is a term well known to one of ordinary skill in the art. Moreover, Applicants have defined aryl at paragraph [0017]. The term "unsubstituted or substituted" is also clear and definite, as one of ordinary skill in the art would clearly understand from what an unsubstituted aryl group is comprised. Finally, Applicants have listed the possible substituents for the substituted aryl. Again, one of ordinary skill in the art would know what "substituted aryl" is in light of these listed possible substituents. Applicants have not disclosed the exact position of the possible substituents. One of ordinary skill in the art would clearly understand that the substituents may be on any chemically acceptable position. For example, a phenyl group may have from one to five substituents on any of the five carbon atoms not bonded outside of the ring structure. Therefore, Applicants respectfully submit that "aryl, ... substituted" is clear and definite under 35 USC 112, second paragraph.

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The Examiner rejects claims 1, 2 and 7 because the term "at least one" is indefinite, as it may include other possibilities. Applicants do not understand the Examiner's basis for this rejection. The term "at least one" is given its plain English meaning. That is, at least one substituent on a phenyl group, for example, may be from one to five substituents. At least one substituent on a naphthyl group may be from one to seven substituents. Applicants submit the term "at least one" is clear and definite. Reconsideration and withdrawal of the rejection of claims 1, 2 and 7 as being indefinite under 35 USC 112, second paragraph, is requested.

Applicants do not understand the Examiner's basis of rejection of claim 8 as being indefinite under 35 USC 112, second paragraph. It appears the Examiner believes that there is no basis for the substituent "-6-(4-hydroxyacetyl)" in independent claim 1. The compound of claim 8 is that of Example 1 of the specification. R^1 is 4-hydroxyacetyl-piperazine, attached to the pyridine ring at its 1-position. The groups "4-hydroxyacetyl" has the structure $-C(O)CH_2OH$. According to claim 1, R^1 may be, inter alia, a six membered non-aromatic heterocycle having 1 or 2 R^7 groups. R^7 is either $-C(O)(CH_2)_mOH$ or oxo. When R^7 is $C(O)(CH_2)_mOH$ and m is 1, and when R^1 is piperazine, then the compound of claim 8 fits into those compounds claimed in claim 1.

Claims 69 and 70 are rejected for being "not very clear" as to what Applicants want to claim. While not acquiescing to the merits of the rejection, Applicants have adopted the Examiner's suggested claim language. Reconsideration and withdrawal of the rejection of claim 69 as being not very clear under 35 USC 112, second paragraph, is requested.

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Claim Rejections – 35 USC 102

The claims stand rejected under 35 USC 102(e) as being anticipated by U.S. Patent No. 6,297,375 ("Bos").

Applicants thank the Examiner for the helpful suggestion that the rejection might be overcome by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of the present application, and is thus not the invention "by another." Applicants submit declarations of each inventor, stating that the subject matter disclosed, but not claimed in Bos, but claimed in the instant application, was derived from the inventor of the instant application.

For this reason, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims as being anticipated by Bos under 35 USC 102(e).

Conclusion

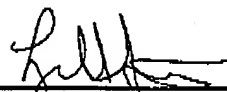
In summary, Applicants respectfully submit that the instant application is in condition for allowance. Early notice to that end is earnestly solicited.

If a telephone conference would be of assistance in furthering prosecution of the subject application, applicants request that the undersigned be contacted at the number below.

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No fee is required in connection with the filing of this Amendment. If any additional fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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